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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,792	07/03/2003	Alexander C. Chan	J6851(C)	7015

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EXAMINER

ELHILO, EISA B

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 08/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/613,792

Applicant(s)

CHAN ET AL.

Examiner

Eisa B. Elhilo

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 5-14 is/are rejected.
- 7) ☒ Claim(s) 2 and 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/14/05 & 7/23/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 1751

Claims 1-14 are pending in this application.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3, 6-7, 8 and 10-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 9, 11-12 and 14-18 of copending Application No. 10/963332, claims 1-4, 5, 10, 11-12 and 14-17 of the copending Application No. 10/691,391 and claims 1-2, 4, 7-9, 11 and 14-19 of the copending Application No. 10/613864. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending Applications No. 10/963,332, 10/691,391 and 10/613,864 teach and disclose similar methods for coloring hair comprising carrying out similar sequential steps of contacting the hair with a dye mixture comprising a primary intermediates and couplers such as p-phenylenediamines as claimed in claim 1 (see claims 1-2 of the copending Application No. 10/963,332, claims 1-4 of the copending Application No. 10/691,391 and claims 1-2 of the copending Application No. 10/613,864), contacting the hair with a developer mixture as claimed in claim 1 (see claim 1 of

Art Unit: 1751

the copending Application No. 10/963, 332, claim 1 of the copending Application No.

10/791,391 and claim 1 of the copending Application No. 10/613,864), the method wherein the

primary intermediates and couplers are presented in the amounts of 0.1 to 10% as claimed in

claim 3 (see claim 5 of the copending Application No. 10/791,391 and claim 4 of the copending

Application No. 10/613,864), the method wherein further applying to the hair an aligning and

distributing means after the hair has been contacted with the oxidative hair dye as claimed in

claims 6-7 (see claims 11-12 of the copending Application No. 10/963,332, claims 11-12 of the

copending Application No. 10/791,391 and claims 7-9 of the copending Application No.

10/613,864), the method wherein the developer mixture comprising an oxidizing agent peroxide

as claimed in claim 8 (see claim 9 of the copending Application No. 10/963,332, claim 10 of the

copending Application No. 10/791,391 and claim 11 of the copending Application No.

10/613,864). The claims copending Applications No. 10/963,332, 10/791,391 and 10/613,864

also teaches kits similar to those as claimed in claims 10-14 (see claims 14-18 of the copending

Application No. 10/963,332, claims 13-17 of the copending Application No. 10/791, 391 and

claims 14-19 of the copending Application No. 10/613,864). Therefore, this is an obvious

formulation.

Although, the claims of the copending Applications No. 10/963,332, 10/791,391 and

10/613,864 teach and disclose similar hair dyeing methods, they are not identical to the instant

claims, because the claims of the copending Application No. 10/963,332, require a fatty

component of components having at least one fatty amine, claims of the copending Application

No. 10/791,391, require that the rate of oxidation of hair dye precursors/rate of diffusion of hair

dye precursors to be less than 1 and the claims of the copending Application No. 10/613864

Art Unit: 1751

require a step of applying a means for aligning the hair, while the instant claims do not require these limitations limitation. Therefore, the conflicting claims are not identical.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize such a method for dyeing hair because the claims of the copending Applications No. 10/963,332, 10/791,391 and 10/613,864, teach and disclose similar method for dyeing hair wherein the oxidative dye mixture is applied to the hair first followed by application of the developing mixture as claimed, and, thus, a person of the ordinary skill would be motivated to utilize such a method for dyeing hair and would expect such a method to have similar properties and similar effect to the hair as those claimed, absent unexpected results.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, ,5, 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarojini et al. (US 2003/0154562 A1).

Sarojini et al (US' 562 A1) teaches a method for coloring hair comprising applying to the hair a mixture of oxidative dye precursors such as para-phenylenediamine followed by contacting the hair with a mixture of oxidizing agents as claimed in claim 1 (see page 10, claim 1 and page 5, paragraph, 0096), the method wherein the primary intermediates are presented in the

Art Unit: 1751

amounts of 0.001 to 5% which overlapped with the claimed range as claimed in claim 3 (see page 2, paragraph, 0041), the method wherein the oxidizing mixture comprising hydrogen peroxide as claimed in claim 8 (see page 5, paragraph, 0096). Sarojini et al. (US' 562 A1) also teaches similar kit as claimed in claim 10 (see paragraph, 11, claim 17).

The instant claims differ from the reference by reciting that the pH of the solution to be selected based on the limitation that less than 50 % of the primary intermediate and couplers compounds are in their anionic form when they first contact the hair.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to be motivated to utilize a composition for dyeing hair having dyeing intermediate compounds with anionic form, because Sarojini et al. (US' 562 A1) teaches dyeing intermediates similar to those claimed (see page 4, paragraph, 0084), and thus a person of the ordinary skill in the art would expect such a method to have similar properties to those claimed, absent unexpected results.

4 Claims 6-7 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarojini et al. (US 2003/0154562 A1) in view of Dias (US 6,540,791 B1)

The disclosure of Sarojini et al. (US' 562 A1) as described above, does not teach or disclose the aligning and distributing means as claimed.

Dias (US' 791 B1) in analogous art of hair dyeing formulation, teaches a method for dyeing hair comprising applying to the hair a distribution means such as comb and brush (see col. 49, lines 25-27)

Therefore, in view of teaching of the secondary reference, one having ordinary skill in the art at the time the invention was made to apply to the hair an aligning and distributing means

Art Unit: 1751

such as brushes or combs with a reasonable expectation of success because Dias (US' 791) clearly teaches that the composition may be applied directly to the hair or via some vehicle such as brushes, combs or applicators (see col. 49, lines 25-27), and, thus, a person of the ordinary skill in the art would be motivated to apply such a vehicle as taught by Dias (US' 791 B1) in the method described be Sarojini et al. (US' 562 A1) and would expect such a method to have similar properties to those claimed, absent unexpected results.

Allowable Subject Matter

5 Claims 2 and 4 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art do not teach or disclose the claimed limitations.

Conclusion

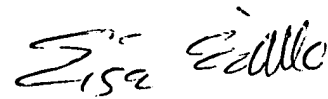
6 The references listed on from 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the rejection above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B. Elhilo whose telephone number is (571) 272-1315. The examiner can normally be reached on M - F (8:00 -5:30) with alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1751

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Eisa Elhilo".

Eisa Elhilo
Patent Examiner
Art unit 1751

August 2, 2005